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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/577,660

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Richard Middleton Hicks

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EXAMINER

CALLAHAN, PAUL E

ART UNIT

PAPER NUMBER

2437

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DELIVERY MODE

08/31/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/577,660	<b>Applicant(s)</b> HICKS, RICHARD MIDDLETON	
	<b>Examiner</b> PAUL CALLAHAN	<b>Art Unit</b> 2437	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6,8-12,14-20,22,24-28,30-34 and 36-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-6, 8-12, 14-20, 22, 24-28, 30-34, and 36-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This Office Action is prompted by the Applicant's response filed 6-16-2010. Claims 1, 2, 4-6, 8-12, 14-20, 22, 24-28, 30-34, and 36-38 are pending and have been examined.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1, 2, 4-6, 8-12, 14-20, 22, 24-28, 30-34, 36 and 37 have been considered but are moot in view of the new ground(s) of rejection.

3. Claim 38 represents claim 7 rewritten in independent form. The previously indicated allowability of (now cancelled) claim 7 is withdrawn in view of a reconsideration of the Atkinson reference. A rejection of claim 38 based on the cited references follow.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1, 2, 4-6, 8-10, 22, 24-28, 30-33 and 37 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

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Claims 1, 2, 4-6, 8-10, and 33 are rejected under 35 U.S.C. 101 based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876). An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. Here, the applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, the claims are non-statutory. The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. *Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.*

As for claims 22, 24-28, 30-32 and 37, the claims are directed towards a computer-readable medium storing computer-readable instructions, however, the claims do not positively recite any limitation that specifies the software as being embodied in a *non-transitory* computer readable medium. Therefore the claims set forth only functional

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descriptive language and are non-statutory since this does not fall into one of the classes of invention eligible for the grant of a US patent. Unless embodied in a non-transitory computer-readable medium the software in and of itself cannot be considered as a computer component, and hence cannot effect a change of state of a processor to produce a useful or tangible result.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cowie et al. US 2003/0023865 A1, Atkinson, US 5,892,904, and Pierre Richer: SANS/GIAC Practical Assignment for GSEC Certification Version 1.4b: Steganalysis: Detecting hidden information with computer forensic analysis, SANS Institute 2003 (Submitted with the Applicant's IDS).

As for claim 38, Cowie teaches a method, comprising, obtaining a signature by reading code comprising a partial section of a program, (fig. 5: element 18, [0015], [0034], [0048]) comparing the signature with one or more computer files (fig. 5: element 18, [0015], [0034], [0048]), and, displaying a listing of which of the one or more

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computer-files provide a match with the signature (fig. 6 element 46, [0050]). Cowie does not teach that the code read is executable code, or that files not accessible to a system administrator are excluded from comparison. However Atkinson does teach these features (col. 7 line 23 through col. 8 line 22: executable code is evaluated, col. 8 lines 30-35: software from trusted sources is automatically downloaded to a user without evaluation and therefore comprises software not accessible to a system administrator since a user may download this software directly). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate these features of Atkinson into the system of Cowie. It would have been obvious to do so since this would increase the probability of detecting hidden malware code in a file, and speeding processing time by excluding already trusted files from evaluation. Cowie fails to teach the feature where the computer-program is a steganographic program configured to introduce steganographic items into a computer file. . However Richer does teach such a feature (page 4: Tools Used to Hide Information, page 6: Detecting Hidden Information With Various Resources: 1.) Guidance Software Inc. where comparisons of an original file MD5 hash is made with a MD5 hash of a suspect file in order to detect steganographically embedded data). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate this feature into the system of Cowie. It would have been obvious to do so since this would extend the types of programs that can be evaluated for embedded malware detectable via the comparison step of Cowie.

***Allowable Subject Matter***

8. Claims 1, 2, 4-6, 8-12, 14-20, 22, 24-28, 30-34, 36 and 37 would be allowable if the rejections under 35 USC Sec. 101 were overcome.

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (571) 272-3869. The examiner can normally be reached on M-F from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Emmanuel Moise, can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is: (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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